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EXAMINER	
HUTTON JR, WILLIAM D	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,395	SPIELBERG, STEVEN	
	Examiner	Art Unit	
	Doug Hutton	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Response

In Applicant's Response dated 09/12/2005, Applicant submitted a Request for Continued Examination, amended Claims 1, 7, 18, 32 and 46, and argued against all rejections previously set forth in the Office Action dated 18 May 2005.

In light of the amendments, all rejections previously set forth are withdrawn.

Continued Examination Under 37 CFR 1.114

A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after Final Rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/12/2005 has been entered.

Correction of Inventorship

In view of the papers filed 03/17/2006, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37

CFR 1.48(a). The inventorship of this application has been changed by adding Samuel Gustman as an inventor.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claim Objections

Claims 13, 15 and 16 are objected to because of the following informalities:

- In Claim 13, the term "*comment*" in Line 3 should be amended to — annotation — because that is how the element is previously identified (see Claim 7, Line 11). Claims 15 and 16 have the same problem.

Claims 31, 45 and 59 are objected to because of the following informalities:

- In Claim 31, the term "said" should be inserted between the term "*of*" in Line 2 and the term "*audio*" in Line 3, because the "*audio elements*" are previously recited in the claims (see Claim 30, Line 2). Claims 45 and 59 have the same problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 18-20, 22-26, 30-34, 36-40, 44-48, 50-54, 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al., U.S. Patent No. 5,732,216.

Claim 1:

Logan discloses *an apparatus for annotating a document* (see Column 1, Lines 42-65; see Column 3, Lines 24-41 – Logan discloses this limitation in that the system allows a user to record an annotation for a text document), *comprising:*

- *a processor* (see Figure 1; see Column 3, Lines 24-41 – Logan discloses this limitation, as clearly indicated in the cited figure and text);
- *memory coupled to said processor* (see Figure 1; see Column 3, Lines 24-41 – Logan discloses this limitation, as clearly indicated in the cited figure and text), *said memory comprising at least one text document* (see Column 3, Lines 24-41 see Column 4, Lines 40-52 – Logan discloses this limitation, as clearly indicated in the cited text);
- *a document processing engine configured to obtain said at least one text document from said memory and convert at least a portion of said at least one*

text document to at least one audio file (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user);

- *an audio output device configured to play said at least one audio file to a first user* (see Column 3, Lines 24-41 – Logan discloses this limitation in that the system comprises the client, which outputs the audio via a speaker);
- *an audio input device configured to obtain at least one verbalized annotation from said user about said at least one audio file while said at least one audio file is playing* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate an annotation concerning a particular portion of the audio), *wherein said at least one verbalized annotation is stored as an audio comment file apart from said at least one audio file* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system stores the annotation in a file that is separate from the audio);
- *an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one annotation* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines

25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates the annotation with a particular portion of the text document about which the annotation is concerned).

Claim 2:

Logan discloses *the apparatus of Claim 1, wherein said memory comprises removable media* (see Column 6, Lines 58-61 – Logan discloses this limitation in that the system downloads the text documents onto a disk, which allows portable use of the text document).

Claim 4:

Logan discloses *the apparatus of Claim 1, wherein said audio file comprises a streaming media file* (see Column 4, Lines 4-16 – Logan discloses this limitation in that the system plays downloaded files in a streaming format).

Claim 5:

Logan discloses *the apparatus of Claim 1, wherein said annotator obtains a start annotation mark from said first user indicating a beginning of said location* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the

audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio).

Claim 6:

Logan discloses *the apparatus of Claim 5, wherein said annotator obtains an annotation end mark identifying the end of said location* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio).

Claim 18:

Logan discloses *a method for annotating a document* (see Column 1, Lines 42-65; see Column 3, Lines 24-41 – Logan discloses this limitation in that the system allows a user to record an annotation for a text document), *comprising:*

- *obtaining a pre-existing document from a memory medium via an interconnection path configured to access said document* (see Column 3, Lines 24-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client via a computer network);
- *converting said document to audio elements* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 –

Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user);

- *presenting an audible playback of said audio elements to a user when said user indicates a desire to hear said document* (see Column 3, Lines 24-41 – Logan discloses this limitation in that the system comprises the client, which outputs the audio via a speaker upon request by the user);
- *obtaining verbalized comments comprising annotations to said document during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate an annotation concerning a particular portion of the audio), *said verbalized comments obtained from said user via an audio input mechanism upon receipt of an annotation start mark during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio);
- *associating said verbalized comments with a location in said document corresponding with the occurrence of said annotation start mark during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see

Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates the annotation with a particular portion of the text document about which the annotation is concerned).

Claim 19:

Logan discloses *the method of Claim 18, wherein said document comprises text data* (Logan discloses this limitation, as indicated in the above rejection for Claim 18).

Claim 20:

Logan discloses *the method of Claim 18, wherein said memory medium comprises removable media* (see Column 6, Lines 58-61 – Logan discloses this limitation in that the system downloads the text documents onto a disk, which allows portable use of the text document).

Claim 22:

Logan discloses *the method of Claim 20, wherein said interconnection path comprises a network* (see Figure 1 – Logan discloses this limitation in that the system connects the client to the server via the Internet).

Claim 23:

Logan discloses *the method of Claim 20, wherein said network comprises a wireless network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a wireless communication network).

Claim 24:

Logan discloses *the method of Claim 20, wherein said network comprises a telephone network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a telephone network).

Claim 25:

Logan discloses *the method of Claim 20, wherein said network comprises a cellular network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a cellular network).

Claim 26:

Logan discloses *the method of Claim 18, wherein a document processing engine performs said converting step* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user).

Claim 30:

Logan discloses *the method of Claim 18, wherein said converting said document to audio elements occurs at a client* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Claim 31:

Logan discloses *the method of Claim 30, wherein said client generates an audio file associated with said presenting said audible playback of audio elements* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Claim 32:

Logan discloses *a method for annotating a document* (see Column 1, Lines 42-65; see Column 3, Lines 24-41 – Logan discloses this limitation in that the system allows a user to record an annotation for a text document), *comprising:*

- *obtaining a document from a memory medium via an interconnection path configured to access said document, said document having text elements* (see

Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user);

- *obtaining from an annotations file a first annotation of said text document, said first annotation having a first set of audio elements* (see Column 32, Lines 29-45; see Column 41, Lines 48-58 – Logan discloses this limitation in that the system comprises downloadable annotations associated with the text document);
- *converting said text elements to a second set of audio elements* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user);
- *associating said first set of audio elements with said second set of audio elements to generate a playback document* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates annotations with particular portions of the text document about which the annotation is concerned);
- *generating an audible playback of said playback document to a user when said user indicates a desire to hear said document* (see Column 3, Lines 24-41 –

Logan discloses this limitation in that the system comprises the client, which outputs the audio via a speaker upon request by the user);

- *obtaining verbalized comments comprising a second annotation of said document during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate an annotation concerning a particular portion of the audio), *said verbalized comments obtained from said user via an audio input mechanism upon activation of an annotation trigger during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio);
- *associating said verbalized comments with a location in said playback document corresponding with the occurrence of said annotation trigger during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates the annotation with a particular portion of the text document about which the annotation is concerned).

Claim 33:

Logan discloses *the method of Claim 32, wherein said document comprises text data* (Logan discloses this limitation, as indicated in the above rejection for Claim 32).

Claim 34:

Logan discloses *the method of Claim 32, wherein said memory medium comprises removable media* (see Column 6, Lines 58-61 – Logan discloses this limitation in that the system downloads the text documents onto a disk, which allows portable use of the text document).

Claim 36:

Logan discloses *the method of Claim 32, wherein said interconnection path comprises a network* (see Figure 1 – Logan discloses this limitation in that the system connects the client to the server via the Internet).

Claim 37:

Logan discloses *the method of Claim 36, wherein said network comprises a wireless network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a wireless communication network).

Claim 38:

Logan discloses *the method of Claim 36, wherein said network comprises a telephone network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a telephone network).

Claim 39:

Logan discloses *the method of Claim 38, wherein said telephone network comprises a cellular network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a cellular network).

Claim 40:

Logan discloses *the method of Claim 32, wherein a document processing engine performs said converting step* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user).

Claim 44:

Logan discloses *the method of Claim 32, wherein said converting said document to audio elements occurs at a client* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to

download the text document from the server to a client, where the text document is converted to audio and played to the user).

Claim 45:

Logan discloses *the method of Claim 44, wherein said client generates an audio file associated with said presenting said audible playback of audio elements* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Claim 46:

Logan discloses *a method for annotating a document* (see Column 1, Lines 42-65; see Column 3, Lines 24-41 – Logan discloses this limitation in that the system allows a user to record an annotation for a text document), *comprising:*

- *generating authentication information of a user desiring access to a pre-existing document* (see Column 10, Lines 40-53 – Logan discloses this limitation in that the system limits access to authorized users);
- *allocating an associations file structure for said user* (see Column 10, Lines 40-53; see Column 12, Line 59 through Column 13, Line 21; see Column 41, Line 28 through Column 42, Line 7 – Logan discloses this limitation in that the system generates sets up private/public folders for the users);

- *obtaining said document from a memory medium via an interconnection path configured to access said document, said document having text elements* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user);
- *obtaining a first pre-existing annotation of said document, said first pre-existing annotation having a first set of audio elements* (see Column 32, Lines 29-45; see Column 41, Lines 48-58 – Logan discloses this limitation in that the system comprises downloadable annotations associated with the text document);
- *converting said text elements to a second set of audio elements* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user);
- *associating said first set of audio elements with said second set of audio elements to generate a playback document* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates annotations with particular portions of the text document about which the annotation is concerned);

- *generating an audible playback of said playback document to said user when said user indicates a desire to hear said document* (see Column 3, Lines 24-41 – Logan discloses this limitation in that the system comprises the client, which outputs the audio via a speaker upon request by the user)*;*
- *obtaining verbalized comments from said user via an audio input mechanism* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate an annotation concerning a particular portion of the audio) *upon activation of an annotation trigger during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio)*, said verbalized comments comprising a second annotation of said document* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate an annotation concerning a particular portion of the audio)*;*
- *associating said verbalized comments with a location in said playback document corresponding with the activation of said annotation trigger during said audible playback* (see Column 12, Line 52 through Column 13, Line 22; see Column 15,

Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates the annotation with a particular portion of the text document about which the annotation is concerned); *and*

- *storing said location and said authentication information of said user and said verbalized comments in said associations file structure* (see Column 3, Lines 24-41; see Column 10, Lines 40-53; see Column 12, Line 59 through Column 13, Line 21; see Column 41, Line 28 through Column 42, Line 7 – Logan discloses this limitation in that the system stores the annotations and the associations in the private/public folders for the users).

Claim 47:

Logan discloses *the method of Claim 46, wherein said document comprises text data* (Logan discloses this limitation, as indicated in the above rejection for Claim 46).

Claim 48:

Logan discloses *the method of Claim 46, wherein said memory medium comprises removable media* (see Column 6, Lines 58-61 – Logan discloses this limitation in that the system downloads the text documents onto a disk, which allows portable use of the text document).

Claim 50:

Logan discloses *the method of Claim 48, wherein said interconnection path comprises a network* (see Figure 1 – Logan discloses this limitation in that the system connects the client to the server via the Internet).

Claim 51:

Logan discloses *the method of Claim 50, wherein said network comprises a wireless network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a wireless communication network).

Claim 52:

Logan discloses *the method of Claim 50, wherein said network comprises a telephone network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a telephone network).

Claim 53:

Logan discloses *the method of Claim 52, wherein said telephone network comprises a cellular network* (see Column 6, Lines 36-58 – Logan discloses this limitation in that the system comprises a cellular network).

Claim 54:

Logan discloses *the method of Claim 46, wherein a document processing engine converts said text elements to a second set of audio elements* (see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system allows the user to download the text document from a server to a client, where the text document is converted to audio and played to the user).

Claim 58:

Logan discloses *the method of Claim 46, wherein said converting said document to audio elements occurs at a client* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Claim 59:

Logan discloses *the method of Claim 58, wherein said client generates an audio file associated with said presenting said audible playback of audio elements* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7-10, 12, 14-17, 28, 29, 42, 43, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan.

Claim 7:

Logan discloses *an apparatus for annotating a document* (see Column 1, Lines 42-65; see Column 3, Lines 24-41 – Logan discloses this limitation in that the system allows a user to record an annotation for a text document)*, comprising:*

- *a client having a text-to-speech engine configured to obtain at least one text document from memory and convert at least a portion of said at least one text document to at least one audio file* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user)*;*
- *a thin-client device configured to obtain said at least one text document from said server* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31; see Column 6, Lines 36-58 – Logan discloses this limitation in that the user downloads the text document

from the server to the client, where the text document is converted to audio and played to the user. Logan also discloses that numerous other storage, processing and communications schemes may be used, including wireless portable computers for use in automobiles.);

- *an audio output device configured to play said at least one audio file to a first user, wherein said audio output device is associated with said thin-client* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the audio is played to the user at the client);
- *said thin-client device having an audio input element configured to obtain at least one verbalized annotation from said user about said at least one audio file while said at least one audio file is playing* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate annotations concerning particular portions of the audio), *wherein said at least one verbalized annotation is transmitted to said server and stored as an audio comment file on said server* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 41, Lines 48-58 – Logan discloses this limitation in that the system uploads the annotations to the server and stores the annotations at the server);
- *said server having an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said*

audio file playing when said first user provided said at least one annotation (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system associates the annotations with particular portions of the text document about which the annotations are concerned).

Logan fails to expressly disclose *a **server** having a text-to-speech engine*. However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a **server** having a text-to-speech engine*,

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claim 8:

Logan discloses that *said thin-client device is connected to said server via an interconnection fabric* (see Figure 1 – Logan discloses this limitation in that the system connects the client to the server via the Internet).

Claim 9:

Logan discloses that *said interconnection fabric comprises a telephone network* (see Figure 1 – Logan discloses this limitation in that the system connects the client to the server via the Internet).

Claim 10:

Logan discloses that *said interconnection fabric comprises a computer network* (see Figure 1 – Logan discloses this limitation in that the system connects the client to the server via the Internet).

Claim 12:

Logan discloses that *said audio comment file is stored in at least one associations file* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system stores multiple annotations associated with a plurality of text documents).

Claim 14:

Logan discloses that *said client comprises a voice command interface* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the system, while the audio is being played to the user, allows the user to orally dictate annotations concerning particular portions of the audio).

Logan fails to expressly disclose *a **server** comprising a voice command interface*. However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a **server** comprising a voice command interface*,

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claim 15:

Logan discloses that *said client is configured to mark the beginning of said verbalized comment upon receipt of a start annotation mark* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio).

Logan fails to expressly disclose *a **server** configured to mark the beginning of said verbalized comment upon receipt of a start annotation mark*. However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a **server** configured to mark the beginning of said verbalized comment upon receipt of a start annotation mark*,

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claim 16:

Logan discloses that *said client is configured to mark the end of said verbalized comment upon receipt of an end annotation mark* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 – Logan discloses this limitation in that the system: 1) allows the user to: a) suspend playback of the audio, and b) record the annotation; and 2) associates the annotation with the particular portion of the audio).

Logan fails to expressly disclose *a **server** configured to mark the end of said verbalized comment upon receipt of an end annotation mark*. However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a **server** configured to mark the end of said verbalized comment upon receipt of an end annotation mark*,

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claim 17:

Logan discloses that *said audio comment file comprises data recorded by said client between receipt of said start annotation mark and said end annotation mark* (see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 – Logan discloses this limitation in that the client stores the annotation).

Logan fails to expressly disclose that *said audio comment file comprises data recorded by said **server***. However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a **server** that records said audio comment file,*

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claims 28, 42 and 56:

As indicated in the above rejections, Logan discloses every limitation of Claims 18, 32 and 46. Logan also discloses that *said converting said document to audio elements occurs at a client* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Logan fails to expressly disclose that *said converting said document to audio elements occurs at a **server***. However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the

art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *said converting said document to audio elements occurs at a* ***server***,

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claims 29, 43 and 57:

As indicated in the above rejections, Logan discloses/teaches every limitation of Claims 28, 42 and 56. Logan discloses that *said client generates an audio file associated with said presenting said audible playback of said audio elements* (see Figure 1; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see Column 4, Lines 40-52; see Column 5, Lines 16-31 – Logan discloses this limitation in that the system comprises a server and allows the user to download the text document from the server to a client, where the text document is converted to audio and played to the user).

Logan fails to expressly disclose a ***server*** *[that] generates an audio file associated with said presenting said audible playback of said audio elements.* However, shifting the performance of network operations from the client to the server, or vice versa, was well-known to one of ordinary skill in the art (e.g., a network administrator) at the time the invention was made, for the purpose of providing sufficient processing power to perform the required network operations.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a* ***server*** *[that] generates an audio file associated with said presenting said audible playback of said audio elements,*

for the purpose of providing sufficient processing power to perform the required network operations, as was well-known to one of ordinary skill in the art at the time the invention was made.

Claims 3, 21, 35 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Merrill et al., U.S. Patent No. 6,181,351.

Claims 3, 21, 35 and 49:

As indicated in the above rejections, Logan discloses every element of Claims 2, 20, 34 and 48.

Logan fails to expressly disclose *a removable memory comprising **flash** memory*.

Merrill teaches *an annotator* (see Column 7, Lines 12-15 – Merrill discloses this limitation in that the system is used to annotate a speech sound data stream) *having removable memory that comprises flash memory* (see Column 5, Lines 32-37 – Merrill discloses this limitation in that the system comprises many different types of computer memory, including flash memory), for the purposes of recording, storing and editing audio files (see Column 9, Lines 20-51).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include *a removable memory comprising **flash** memory*, for the purpose of recording, storing and editing audio files, as taught by Merrill.

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Groner, U.S. Patent No. 6,507,643.

Claim 11:

As indicated in the above rejection, Logan discloses/teaches every limitation of Claim 9.

Logan fails to expressly disclose/teach *a thin-client device comprising a telephone.*

Groner teaches a communication system comprising a telephone connected to the Internet that allows a user to review text messages. When the caller opts to review a text message, the system converts the text messages to audio and plays them to the caller. See Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50. This teaching discloses *a thin-client device comprising a telephone.*

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *a thin-client device comprising a telephone,*

for the purpose of allowing a user to send text messages to a recipient, as taught in Groner (see Column 2, Lines 54-57).

Claim 13:

Logan fails to expressly disclose/teach *an annotator associated with a Speech Recognition Engine configured to obtain said audio comment file and convert said verbalized comment back to text.*

Groner teaches a communication system that allows a user to verbally edit text messages while listening to the text messages via a telephone. The system converts the verbal edits made by the caller into text and inserts the edits into the appropriate positions in the text messages. See Column 10, Lines 19-50. This teaching discloses *a Speech Recognition Engine configured to obtain an audio comment file and convert a verbalized comment back to text.*

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include:

- *an annotator associated with a Speech Recognition Engine configured to obtain said audio comment file and convert said verbalized comment back to text,*

for the purpose of allowing a user to send text messages to a recipient, as taught in Groner (see Column 2, Lines 54-57).

Claims 27, 41 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Gupta et al., U.S. Patent Application Publication No. US 2003/0196164 A1.

Claims 27, 41 and 55:

As indicated in the above rejection, Logan discloses every element of Claims 26, 40 and 46.

Logan fails to expressly disclose *a document processing machine [that] optimizes said audio elements.*

Gupta teaches *a method for annotating a document* (see Figure 1; see Paragraph 0001 – Gupta discloses this limitation in that the system includes annotations to corresponding media content.) comprising:

- *a document processing machine [that] optimizes audio elements* (see Paragraphs 0049-0057 – Gupta discloses this limitation in that the system includes a media server that processes an audio file by dropping short segments from the speech signal at regular intervals and performing cross fading or smoothing between adjacent segments),

for the purpose of improving the resulting sound quality of the audio file (see Paragraph 0053).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Logan, to include:

- *a document processing machine [that] optimizes said audio elements,*

for the purpose of improving the resulting sound quality of the audio file, as taught by Gupta.

Response to Arguments

Applicant's arguments with respect to Claims 1-59 have been considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
April 4, 2006

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